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In re Application of : DECISION
WILLIAM PLENDERLEITH : ON
U.S. Application No.: 09/989,351 : RENEWED
Filing Date: November 20, 2001 : PETITION
Attorney's Docket No.: 717901.16 : UNDER
For: SPORTS VEHICLE : 37 CFR 1.182

This is in response to applicant's "Renewed Petition Under 37 CFR Section 1.182" filed 23 September 2002.

BACKGROUND

On 22 May 2000, applicant filed an international application PCT/GB00/01926, which claimed priority of United Kingdom application no. 9911843.2 filed 22 May 1999.

On 20 November 2001, applicant filed a "UTILITY PATENT APPLICATION TRANSMITTAL" letter for filing of a new nonprovisional application under 37 CFR 1.53(b) in the United States, which was accompanied by, *inter alia*,: the filing fee, a specification, drawings, claims, abstract, preliminary amendment and an executed declaration.

On 11 January 2002, the applicant's attorney contacted the USPTO to ascertain why the Notice of Acceptance (PCT/DO/EO/903) was never received by the applicant. The examiner in charge of the application informed the attorney that the application was forwarded to the Office of the PCT Legal Administration. Subsequently, a Special Programs Examiner from the PCT Legal Administration Office called the attorney and verified that the instant application was accepted as a by-pass continuation patent application and not a national phase patent application filed under 37 CFR 371.

On 14 February 2002, applicant filed "Petition for Correction of National Phase Filing Status for a Patent Application Under 37 CFR Section 1.182".

On 23 July 2002, the Office mailed "Decision on Petition Under 37 CFR 1.182" dismissing applicant's petition without prejudice.

On 23 September 2002, applicant filed the present renewed petition.

DISCUSSION

Applicant contends that the instant bypass application was clearly and unequivocally intended to be filed as a US national phase patent application. The applicant admits that a standard utility patent application transmittal letter was inadvertently utilized which resulted in the instant application being treated as a bypass application. However, the applicant argues that other evidence, i.e. filing of preliminary amendment addressed to Box PCT, clearly shows the applicant's intent of filing the instant application as a national phase filing.

As indicated in the prior petition decision mailed on 23 July 2002, any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The "UTILITY PATENT APPLICATION TRANSMITTAL" filed on 20 November 2001 indicated that the application was a filing of a new nonprovisional application under 37 CFR 1.53(b). The transmittal letter used by applicant is to be used only with submissions under 35 U.S.C. 111(a). Note that the letter has the statement "(Only for new nonprovisional applications under 37 CFR 1.53(b))". The filing under 37 CFR 1.53(b) is only directed to application filed under 35 U.S.C. 111(a). Applicant thus did not give specific instructions to enter the national stage. Therefore, the application was properly treated by OIPE as a filing under 35 U.S.C. 111(a).

Even if there were other evidences to support the filing of this application as a national stage application, e.g. the preliminary amendment being addressed to Box PCT, the box for a continuing application information on the transmittal letter not being checked, etc., the transmittal letter would have been considered as conflicting instructions and the papers would have been rightfully considered as having been filed under 35 U.S.C. 111(a).

Consequently, the application is deemed to have been filed under 35 U.S.C. 111(a).

Further, the applicant argues that a bypass continuation application of a PCT application can not be filed with only a preliminary amendment. However, in the instant application, the applicant's preliminary amendment included a substitute specification which rendered the application complete. Consequently, since there was nothing to prevent the applicant from obtaining a filing date in the instant application, the application was correctly processed as a bypass continuation application.

As regards to double patenting, contrary to the applicant's argument, the applicant is not barred from filing two applications even if they are directed to the "same invention". Rather, the applicant is only prohibited from obtaining patents to "same invention".

As regards to the priority documents, although a certified copy of the priority document UK 9911843.2 is required, a certified copy of the PCT international application PCT/GB00/01926 is not required since it was published in English.

CONTINUATION APPLICATION

However, applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 09/989,351) and the international application (PCT/GB00/01926) designating the United States were copending on 20 November 2001. In order to obtain benefit of the earlier international application, applicant must amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is a continuation of International Application PCT/GB00/01926, with an international filing date of May 22, 2000, published in English under PCT Article 21(2), and now abandoned."

As regards to the applicant's requirement for submission of the priority documents, a certified copy of the priority document UK 9911843.2 and a certified copy of the PCT international application PCT/GB00/01926 have been received in the instant application.

CONCLUSION

For the reasons stated above, the renewed petition under 37 CFR 1.182 is **DISMISSED** without prejudice.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P. O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

This application is being returned to the Technology Center 3600 for continued prosecution.

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